

REMARKS

Claims 1, 4, 7, 10, 11 and 12 are amended. Claim 2 is cancelled. Claims 1, and 3 through 12 are under consideration. Reconsideration of all amended and original claims is respectfully requested.

Rejection Under 35 U.S.C. § 112 Rejection

Claims 1-9 and 12 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter of the invention.

In Paragraphs 9 and 10 the Action points out informalities in claim 1 and dependent claims 2-9. In response, claim 1 has been amended to correct the informalities. Claim 2 is cancelled.

In paragraphs 11 and 12 , the Action states that the term “key fields” renders claims 4 and 6 respectfully, indefinite.

In response, applicant has amended the claim 4.

In Paragraph 13 the Action rejects Claim 7. In response, the informality has been corrected.

In Paragraph 14, the Action rejects claim 9.

In response, claim 9 is amended

In Paragraphs 15 and 16 , claim 12 is rejected. In response applicant has corrected the informality.

In summary, the above amendments correct all of the deficiencies, and therefore, rejection of claims 1, and 3-10, and 12 should be withdrawn.

35 U.S.C. § 102 (e) Rejections

The Examiner rejected claims 1 and 3-12 under 35 U.S.C. § 102 (e) as being anticipated by Stimac (US Patent Application Publication 2003/0071852—“the ‘852 application”).

Invention disclosures

The Stimac Patent Application, having a priority date of June 5, 2001 (Applicants’ application has a priority date of July 31, 2001), describes a method and system for screening job applicants by using at least one input device to receive questions about a job opening and job applicants, and a processor that processes the data input above, and ranks the job applicants. (see claim 28 of the ‘852 application). The Stimac Patent Application however, does not have an essential element connected to the process controller. In other words, the Stimac ‘852 application is focused on rapid screening of applicants for positions that are common and where there is high volume numbers of applicants but does not take into account the accounting component. The ‘852 application provides a rapid resume processing system and although it mentions interviewing as a minor step in the overall system, it does not make interviewing an essential element of the invention.

In contrast, the present invention places great focus the cost and accounting component of the system in addition to the interviewing function and related best practices, and therefore, the key elements of the invention are the management and coordination of the interview teams, use of multiple interviewers, team building, avoidance of redundancy in duplicating interview questions, and ultimately providing a

more accurate evaluation of the applicants and correct hiring decisions. (See Appendix for several references from the specification for support).

In paragraph 19, the Action rejects claim 1.

In response, applicants submit amendments in claim 1 that clearly show that the prior art element is not an equivalent of the structure, the data records or acts disclosed in the present invention, as explained in the invention disclosures above and as represented in the amended claim 1. Applicants have reviewed the cited paragraphs of the '852 application and conclude that, Stimac does not teach a computer readable medium having an accounting system connected to the process controller. Even the Action admits that in paragraph 34. Therefore this rejection should be withdrawn.

In paragraph 20, the Action rejects claim 10

In response, applicants submit that as for claim 1 above, amendments in claim 10 that clearly show that the prior art does not have the accounting system connected to the process controller or an equivalent of the structure, the data records or acts disclosed in the present invention, as explained in the invention disclosures above and as represented in the amended claim 10. Therefore this rejection should be withdrawn

In paragraph 21, the Action rejects claim 11.

In response, applicants submit amendments in claim 11 clearly show that the prior art does not teach the accounting system connected to the process controller. Applicants have reviewed the cited paragraphs of the '852 application for each sub-part of amended claim 11 and conclude that, the materials disclosed are different and distinguishable. Therefore this rejection should be withdrawn.

In paragraph 22, the Action rejects claim 3. (dependent on claim 1)

In paragraph 23, the Action rejects claim 4. (dependent on claim 1)

In paragraph 24, the Action rejects claim 5 (dependent on claim 1)

In paragraph 25, the Action rejects claim 6. (dependent on claim 4)

In paragraph 26, the Action rejects claim 7.. (dependent on claim 4)

In paragraph 27, the Action rejects claim 8. (dependent on claim 5)

In paragraph 28, the Action rejects claim 9. (dependent on claim 7)

In paragraph 29, the Action rejects claim 12. (dependent on claim 11)

In response, applicants submit that the amendments made in claim 1, 10, and 11 apply to claims 3, 4, 5, 6, 7, 8, 9 and 12, and therefore these dependent claims are distinguishable from Stimac. Therefore the above rejections should be withdrawn.

Since under the case law, for a rejection to be upheld under section 102(e) of 35 USC, "...every element of the claimed invention must be identically shown in a single reference...these elements must be arranged as in claim under review" (In re Bond, 910 F.2nd 831, 15 USPQ 2nd 1566). Therefore, under In re Bond, the cited art, Stimac, does not anticipate the invention. This is because several essential elements, specifically, the accounting system connected to the process controller, of the present invention are not present in the cited prior art. Applicants have also shown that the prior art is not an equivalent of the structure, material, or acts disclosed in the present application. See In re Mulder, 716 F.2d 1542, 1549, 219 USPQ 189, 196 (Fed. Cir. 1983). Therefore, all of the rejections under section 102 above should be withdrawn.

35 U.S.C. § 103 Factual Inquiries and Rejections

Applicant submits that the subject matter of the various claims was commonly owned at the time of the invention covered, in considering patentability under section 103(a).

In paragraphs 32-34, *the Action states Claim 2 is rejected Stimacin view of Taylor (U.S. Patent 5,832,497). Stimac does not explicitly teach a computer readable medium further comprising an accounting system connected to said process controller.*

The Action states: Taylor, however, teaches an accounting system connected to said process controller (col 2, line 13; see also col 6, lines 47-57). It would have been obvious to one of ordinary skill in the art at the time of the invention to include an accounting system, since this would allow the operator of the system to charge a fee for its use (see col 6, lines 47-57).

In paragraphs 35-39, the Action responds to arguments presented in previous response. The Action states that the examiner disagrees that combination of Stimac and Taylor references is result of impressible hindsight, and that “*the rejection of record provides ample motivation of incorporating an accounting system into the system of Stimac, said motivation provided by the Taylor reference it self*”. See paragraph 39 of the Action.

In response to paragraphs 32-39, applicants disagree. In any event claim 2 is cancelled, and its limitation- the accounting system – incorporated in claim 1.

Applicant refers to MPEP 2141.02 and specifically points out that in determining the differences between the prior art and the claims, the question under 35 USC 103, is not whether the differences themselves would have been obvious, but whether the

claimed invention as a whole would have been obvious. Stratoflex, Inc. v. Aeroquip Corp. 713 F. 2d 1530 218 USPQ 871 (Fed. Cir. 1983).

The Action cites Taylor for describing the accounting system. However, Taylor neither suggests or teaches the present invention. Taylor's invention manages a database of job postings and the function of the accounting system in Taylor is track the charges to employer-users who access the system to get information on applicant users.

The present invention includes a database of job postings as one of many applications of the system which include a) a comprehensive multi-user web-based hiring application, b) security system, c) tools for sharing and interacting with the system, d) position modules, e) candidate modules, f) interview modules, g) report modules and h) an accounting system capable of tracking the cost of hiring and reducing the cost through better interaction of the different components a) through g). Accordingly, it would be clear to one of ordinary skill in the art that the accounting system of Taylor and that of the present invention are different.

As a matter of law, the above rejection cannot be sustained. The Federal Circuit, in reference to references cited in an obviousness rejection, has held that: "The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention." Hodosh v. Block Drug Co., Inc., 786 F.2d 1136, 1143 n.5, 1986 MPEP 2141.

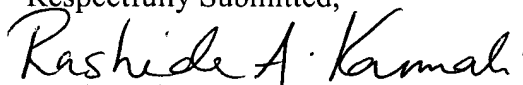
"To make a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure." In re Vaack 947 F. 2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) (MPEP §2143 and 2142).

“ When the motivation to combine the teachings of the references is not immediately apparent, it is the duty of the examiner to explain why the combination of the teachings is proper”. Ex parte Skinner, 2 USPQ 1788 (Bd. Pat. App. & Inter. 1986).

In this regard, there is no teaching or suggestion whatsoever in Stimac of an accounting system. And, similarly, there is no teaching or suggestion of the multi-user web-based hiring system of the present invention in Taylor. Moreover, the examiner has not provided a factual explanation as to how motivation is provided by Taylor.

Therefore, as a matter of fact and law, there is no basis to sustain the rejection of any of the claims under consideration 1, 3-12, as being obvious over Stimac in view of Taylor. This rejection should be withdrawn.

If for any reason, the Examiner should deem this application not in condition for allowance, the Examiner is respectfully requested to telephone the undersigned attorney to resolve any outstanding issues prior to issuing a further Office Action.

Respectfully Submitted,

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